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Remarks

A. Interview

During the Telephone Interview on December 14, 2006, Applicant's counsel requested clarification regarding the Examiner's October 20, 2006 final rejection. Applicant questioned if a declaration were submitted would it result in allowance of the case. The Examiner indicated that he could not comment on it until he reviewed the declaration. Applicant's counsel also questioned whether or not the Examiner was satisfied with the argument set forth in the September 21, 2006 Reply indicating that a limitation on how the catalyst was made was a limitation in the method of oxidizing CO. The Examiner indicated the he still felt it was an issue.

B. Specification

The Examiner has indicated that the status of the parent application should be updated in the specification of the application. Applicant does not believe this necessary. 37 CFR 1.78(a)(2)(i) sets forth the requirement for referencing a prior application for which the benefit of the filing date is claimed:

Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate

Nothing in the statute, rule, or the Manual of Examination Procedure requires that the Specification be amended to indicate the status of the parent application. If the Examiner believes this is a requirement, Applicant would like the Examiner to cite a rule for such a requirement.

C. Claim Objection

The Examiner objected to claim 21 because of the misspelling of the word said. Applicant has amended claim 21 so that the spelling of the word “said” is correct.

D. 35 USC 103 Rejection

Claims 1-26 have been rejected by the Examiner as being obvious over Plzak.

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citations omitted).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP 706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner in the Office Actions has not shown that the prior art suggests or teaches all of the claim limitations.

Claim 1 – Limitations not Shown in Plzak

Plzak does not require an activation step. Plzak does not show or discuss activation for 12 hours.

Claim 12 - Limitations not Shown in Plzak

Activating said catalyst by passing through said catalyst a mixture of hydrogen and oxygen in a ratio by volume of about 0.25/65 to 6/65 for at least 12 hours, wherein the gold in said catalyst is present in an amount from 0.25% to 10% by weight of the iron in said catalyst.

Claim 21 – Limitations not Shown in Plzak

activating said catalyst by passing a hydrogen and oxygen containing gas through said catalyst for at least 12 hours at a temperature of 60-90°C

Plzak does not disclose the time period of 12 hours. The specification and claims require activation of the catalyst for at least 12 hours. The Examiner must accept the applicant's statement as true or disprove the statement.

The Examiner in discussing the activation of the catalysts states, it is expected that the iron gold containing catalyst will also be inherently activated as it oxidizes the carbon monoxide in the oxygen and hydrogen containing gas. Page 3 of October 20, 2006 Office Action. The conclusion by the Examiner that activation is inherent without any support in the reference is not sufficient to establish inherency.

MPEP Section 2112(IV) reads as follows:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In *re* Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In *re* Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In *re* Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.). >Also, "[a]n invitation to investigate is not an inherent disclosure" where a prior art reference "discloses no more than a broad genus of potential applications of its discoveries." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that "[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category" but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species.<

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the

balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

In *In re Rijckaert* case the United States Patent and Trademark Office tried to argue that claim requirements were inherent in the prior art because the claim requirements were optimal conditions. The Federal Circuit reversed because the optimal condition was not described in the prior art.

In this case Plzak does not describe an activation step. In addition Plzak does not mention that the activation has to occur for at least 12 hours.

The Examiner has not met its burden in proving a prima facie case of obviousness.

E. Conclusion

In view of the above, it is submitted that the claims now presented in the application are in condition for allowance. Accordingly, reconsideration and allowance of the claims are requested.

Respectfully submitted,



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